



IPW

Attorney Docket No. 259.US  
**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Birkus et al.

Serial No.: 10/511,183

Group No.: 1648

Filed: October 14, 2004

Examiner:

For: METHOD AND COMPOSITIONS FOR IDENTIFYING ANTI-HIV  
THERAPEUTIC COMPOUNDS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL**

We are transmitting herewith the enclosed:

- ☒ Communication RE: Notification of Requirements (2pgs.)
- ☒ Copy of Notification of Missing Requirements...(2 pgs.)
- ☒ Copy of Transmittal Letter (1 pg.)
- ☒ Copy of Signed Combined Declaration and Power of Attorney (4 pgs.)
- ☒ Copy of stamped post card (1pg.)
- ☒ A return postcard.

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**CERTIFICATE OF MAILING (37 CFR 1.8 (a))**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

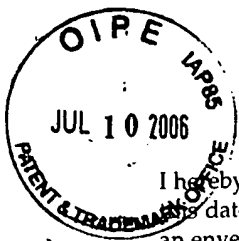
Date:

July 7, 2004

Sharon A. Lira

(Type or print name of person mailing paper)

  
(Signature of person mailing paper)



I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

Date: July 7, 2006

Sharon A. Lira  
(Type or print name of person mailing paper)  
[Signature]  
(Signature of person mailing paper)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|                                    |   |                   |
|------------------------------------|---|-------------------|
| In re PATENT APPLICATION of        | ) |                   |
|                                    | ) |                   |
| Birkus et al.                      | ) | Docket No. 259.US |
|                                    | ) |                   |
| Serial No: 10/511,183              | ) |                   |
|                                    | ) |                   |
| Filed: February 23, 2005           | ) |                   |
|                                    | ) |                   |
| Title: METHOD AND COMPOSITIONS FOR | ) |                   |
| IDENTIFYING ANTI-HIV THERAPEUTIC   | ) |                   |
| COMPOUNDS                          | ) |                   |

**COMMUNICATION RE: INCORRECT FILING RECEIPT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir/Madam:

Applicant hereby requests correction of the Filing Receipt with respect to the above-identified patent application. In the Filing Receipt "Date Mailed" on January 17, 2006 (copy enclosed), the seventh inventor's first name is incorrectly listed as "Gon-Xi He." It should be Gon-Xin He. The Combined Declaration and Power of Attorney (copy enclosed) mailed on February 23, 2005 was signed by said inventor with the correct spelling.

Applicant would appreciate correction of the above-identified error and that a new "corrected" filing receipt be sent.

Date: \_\_\_\_\_

7/2/06

Respectfully submitted,

By \_\_\_\_\_



Allan N. Kutzenco, Reg. No.: 38,945

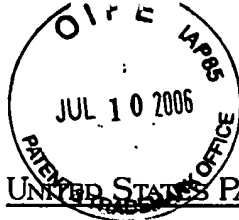
Gilead Sciences, Inc.

333 Lakeside Drive

Foster City, CA 94404

Phone: (650) 522-6101

Fax: (650) 522-5575



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

| APPL NO.                | FILING OR 371<br>(c) DATE | ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO     | DRAWINGS | TOT CLMS | IND CLMS |
|-------------------------|---------------------------|----------|---------------|---------------------|----------|----------|----------|
| 10/511,183<br><i>Ch</i> | 02/23/2005<br><i>Ch</i>   | 1648     | 3078          | 259.US<br><i>Ch</i> |          | 70       | 8        |

CONFIRMATION NO. 1944

Gilead Sciences I  
 333 Lakeside Drive  
 Foster City, CA 94404

RECEIVED JAN 24 2006

## FILING RECEIPT



\*OC000000017834374\*

Date Mailed: 01/17/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

*Ch* Gabriël Birküs, Foster City, CA;  
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*Ch* William A Lee, Los Altos, CA;  
*Ch* Martin J McDermott, Redwood City, CA;  
*Ch* Sundaramoorthi Swaminathan, Burlingame, CA;

7203

## Power of Attorney:

Mark Bosse--35071

## Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US03/12943 04/25/2003 *Ch*  
 which claims benefit of 60/375,665 04/26/2002 *Ch*  
 and claims benefit of 60/375,834 04/26/2002 *Ch*  
 and claims benefit of 60/375,779 04/26/2002 *Ch*  
 and claims benefit of 60/375,622 04/26/2002 *Ch*

## Foreign Applications

If Required, Foreign Filing License Granted: 01/11/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US10/511,183**

Projected Publication Date: 04/20/2006

Non-Publication Request: No

Early Publication Request: No

**Title**

Method and compositions for identifying anti-hiv therapeutic compounds

38  
EX-100

**Preliminary Class**

435

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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**LICENSE FOR FOREIGN FILING UNDER**  
**Title 35, United States Code, Section 184**  
**Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

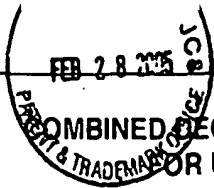
The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



**COMBINED DECLARATION AND POWER OF ATTORNEY  
FOR UTILITY PATENT APPLICATION**

Docket No. 259.US



AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:

My residence, post office address and citizenship are as stated below next to my name.

I BELIEVE I AM THE ORIGINAL, FIRST AND SOLE INVENTOR (if only one name is listed below)  
OR AN ORIGINAL, FIRST AND JOINT INVENTOR (if more than one name is listed below) OF THE  
SUBJECT MATTER WHICH IS CLAIMED AND FOR WHICH A PATENT IS SOUGHT ON THE  
INVENTION

Entitled: **Method and Compositions for Identifying Anti-HIV Therapeutic  
Compounds**

the specification of which:

(check one) \_\_\_ is attached hereto:

X was filed on October 14, 2004 as

Application Serial No. 10/511,183

and was amended on \_\_\_\_\_;  
(if applicable)

I HAVE REVIEWED AND UNDERSTAND THE CONTENTS OF THE ABOVE-IDENTIFIED  
SPECIFICATION, INCLUDING THE CLAIMS, AS AMENDED BY ANY AMENDMENT REFERRED  
TO ABOVE.

I acknowledge and understand that I am an individual who has a duty to disclose information  
which is material to the patentability of the claims of this application in accordance with Title 37,  
Code of Federal Regulations, §§ 1.56(a) and (b) which state:

"(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

COPY

**COMBINED DECLARATION AND  
POWER OF ATTORNEY**

Docket No. 259.US

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability."

**CLAIM FOR BENEFIT OF PRIOR U.S. PROVISIONAL APPLICATION(S)**  
(34 U.S.C. § 119(e))

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below:

|                   |       |                       |
|-------------------|-------|-----------------------|
| <u>60/375,622</u> | filed | <u>April 26, 2002</u> |
| <u>60/375,779</u> | filed | <u>April 26, 2002</u> |
| <u>60/375,834</u> | filed | <u>April 26, 2002</u> |
| <u>60/375,665</u> | filed | <u>April 26, 2002</u> |

I do not know and do not believe this invention was ever known or used in the United States of America before my or our invention thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to said application. This invention was not in public use or on sale in the United States of America more than one year prior to this application. This invention has not been patented or made the subject of an inventor's certificate issued before the date of this application in any country foreign to the United States of America on any application filed by me or my legal representatives or assigns more than twelve months prior to this application.

I hereby appoint the following attorneys and agents to prosecute said application and to transact all business in the Patent and Trademark Office connected therewith and to file, to prosecute and to transact all business in connection with all patent applications directed to said invention:

Mark L. Bosse - Reg. No. 35,071  
William Schmonsees - Reg. No. 31,796  
James J. Wong - Reg. No. 34,949

and: \_\_\_\_\_

Address all correspondence to: **GILEAD SCIENCES, INC.**  
333 Lakeside Drive  
Foster City, California 94404

Address all telephone calls to: James J. Wong at 650-522-5823

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of First Inventor  
Gabriel Birkus

Signature

*Gabriel Birkus*

Date

11/11/04

Residence

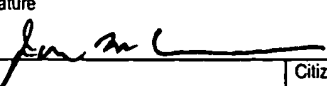
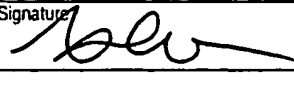
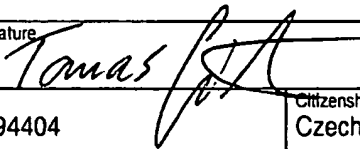
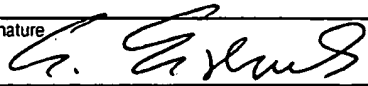
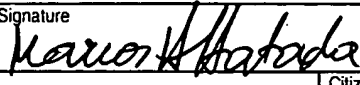
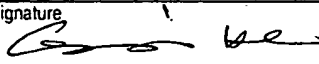

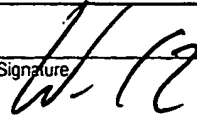
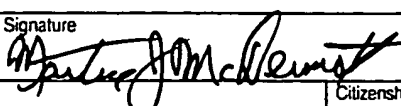
737 Catamaran St., #4, Foster City, California 94404

Citizenship


Slovakia

COPY



|  |  |                       |
|--|--|-----------------------|
| Post Office Address<br>same as above   |  |                       |
| Full Name of Second Inventor<br>James M. Chen                                | Signature<br>   | Date<br>Nov. 9 2004   |
| Residence<br>4015 Marblehead Drive, San Ramon, California 94583              | Citizenship<br>United States of America  |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Third Inventor<br>Xiaowu Chen                                   | Signature<br>   | Date<br>Nov. 9, 2004  |
| Residence<br>377 Laurie Meadows Drive, Apt. 319, San Mateo, California 94403 | Citizenship<br>United States of America  |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Fourth Inventor<br>Tomas Cihlar                                 | Signature<br>   | Date<br>Nov 10, 2004  |
| Residence<br>740 Chebec Lane, Foster City, California 94404                  | Citizenship<br>Czech Republic  |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Fifth Inventor<br>Eugene J. Eisenberg                           | Signature<br>   | Date<br>Nov. 10, 2004 |
| Residence<br>236 Club Drive, San Carlos, California 94070                    | Citizenship<br>United States of America  |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Sixth Inventor<br>Marcos Hatada                                 | Signature<br>  | Date<br>Nov 10, 2004  |
| Residence<br>2000 Walnut Avenue, Apt. G302, Fremont, California 94538        | Citizenship<br>United States of America  |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Seventh Inventor<br>Gong-Xin He                                 | Signature<br> | Date<br>Nov. 9, 2004  |
| Residence<br>5436 Ontario Common, Fremont, California 94555                  | Citizenship<br>Peoples Republic of China   |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Eighth Inventor<br>Choung U. Kim                                | Signature<br> | Date<br>Nov. 11, 2004 |
| Residence<br>1750 Elizabeth Street, San Carlos, California 94070             | Citizenship<br>United States of America  |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Ninth Inventor<br>William A. Lee                                | Signature<br> | Date<br>Nov 11, 2004  |
| Residence<br>749 Anderson Drive, Los Altos, California 94024                 | Citizenship<br>United States of America  |                       |
| Post Office Address<br>same as above   |  |                       |
| Full Name of Tenth Inventor<br>Martin J. McDermott                           | Signature<br> | Date<br>Nov. 9, 2004  |
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| Post Office Address<br>same as above   |  |                       |

COPY

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|--|--|---|--|----------------------|--|
| Full Name of Eleventh Inventor<br>Sundaramoorthi Swaminathan   |  | Signature<br> |  | Date<br>Nov 9 2004   |  |
| Residence<br>2858 Hillside Drive, Burlingame, California 94010 |  |   |  | Citizenship<br>India |  |
| Post Office Address  |  |   |  |                      |  |
| Full Name of Inventor  |  | Signature   |  | Date                 |  |
| Residence  |  |   |  | Citizenship          |  |
| Post Office Address  |  |   |  |                      |  |
| Full Name of Inventor  |  | Signature   |  | Date                 |  |
| Residence  |  |   |  | Citizenship          |  |
| Post Office Address  |  |   |  |                      |  |
| Full Name of Inventor  |  | Signature   |  | Date                 |  |
| Residence  |  |   |  | Citizenship          |  |
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| Full Name of Inventor  |  | Signature   |  | Date                 |  |
| Residence  |  |   |  | Citizenship          |  |
| Post Office Address  |  |   |  |                      |  |
| Full Name of Inventor  |  | Signature   |  | Date                 |  |
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| Full Name of Inventor  |  | Signature   |  | Date                 |  |
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YPOC